



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Miettinen-Oinonen *et al.*

Appl. No.: 10/825,378

Filed: April 16, 2004

For: **Novel Cellulases, The Genes
Encoding Them and Uses Thereof**

Confirmation No.: 8318

Art Unit: 1652

Examiner: Patterson, Charles L. Jr.

Atty. Docket: 1716.0510009/TJS/LDB

Reply to Restriction Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated April 14, 2006, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 31-106, 110-119, 123-132, 136-145 and 149-153. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made with traverse.

As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 802.01, § 806.06 and § 808.01) or distinct (MPEP § 806.05 – § 806.05(j)).

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

See M.P.E.P. § 803, Eight Edition, Revised August 2005. Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." In the present situation, no such showing has been made.

Although the Examiner has asserted that each of the sequences are different proteins that are structurally different, Applicants submit that the claims in the present application are all directed to methods for biostoning, biofinishing, treating wood-derived pulp or fiber, or improving animal feed using cellulase enzymes. Thus, a search for the subject matter of Group I would also provide useful information for the subject matter of all other groups. Applicants respectfully submit that to search and examine the subject matter of all the groups together would not impose a serious burden on the Examiner.

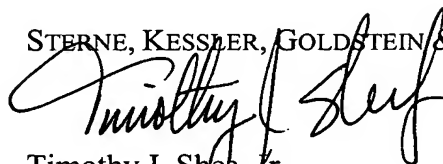
Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees

required therefor are hereby authorized to be charged to our Deposit Account No.
19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Timothy J. Shea, Jr.
Attorney for Applicants
Registration No. 41,306

Date: June 14, 2006

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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